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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,189	07/30/2001	Yoshihiko Yamaguchi	2001-1067A	7587

513 7590 01/28/2004

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WASHINGTON, DC 20006-1021

EXAMINER

MULCAHY, PETER D

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/28/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/890,189

Applicant(s)

YAMAGUCHI, YOSHIHIKO

Examiner

Peter D. Mulcahy

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-28404 or Takiguchi et al. US 4,421,839.

The rejection under 35 U.S.C. 103 as set forth in paper #5 is deemed proper and is herein repeated. Applicants arguments have been fully considered and have been found to be not persuasive.

With respect to the rejection over Takiguchi et al. applicants argue that the instantly claimed invention is directed to "[A] magnetic rubber composition for encoder..." and that the prior art is not directed to solving the same problem. This is not persuasive. The claims are directed to a composition which is limited by its ingredients. There are no structure limitations which limit the claimed invention to the problem/application as identified in the preamble. The prior art shows magnetic compositions having ingredients which render obvious those as claimed. The fact that the prior art discloses the magnetic composition as a magnetic recording layer does not render the claimed invention patentable.

It is further argued that the nitrile rubber as claimed is not disclosed or suggested by the prior art. This is not persuasive. The patent teaches the incorporation of a nitrile rubber in the magnetic recording layer, see col. 7, lines 16-20. The specific monomeric composition and degree of hydrogenation of the rubber is not specifically identified with

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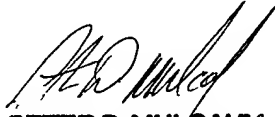
in the patent. One of ordinary skill in the art is directed to select a commercially available nitrile rubber for the magnetic recording layer. There is nothing in the patent which would direct one away from a nitrile rubber as claimed and to the contrary, the claimed nitrile rubber is a commercially available product, see the specification at page 8 in example 1. There remains no showing or allegation of record as to unexpected results obtained by using a nitrile rubber as claimed when compared nitrile rubbers which are outside the scope of the claims.

The Japanese abstract also discloses magnetic rubber compositions which have the claimed functional ingredients and are based on a "specific nitrile rubber." Given the breadth of the claims and the commercial availability of the rubber, it would be reasonable to presume that the rubber disclosed within the document either anticipates or renders obvious the claimed rubber ingredient. The examiner will submit the document for translation.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (571) 272-1700.

PDM

January 26, 2004

  
**PETER D. MULCAHY**  
**PRIMARY EXAMINER**